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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/693,156

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Arch D. Robison

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INTEL/BSTZ

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EXAMINER

KISS, ERIC B

ART UNIT

PAPER NUMBER

2192

MAIL DATE

DELIVERY MODE

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/693,156	<b>Applicant(s)</b> ROBISON, ARCH D.	
	<b>Examiner</b> ERIC B. KISS	<b>Art Unit</b> 2192	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 10 September 2008.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 10,12-19 and 21-27 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 10,12-19 and 21-27 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

### **DETAILED ACTION**

1. The reply filed September 10, 2008, has been received and entered. Claims 10, 12-19, and 21-27 are pending.
2. The rejection of claims 13 and 21-27 under 35 U.S.C. § 112, is withdrawn in view of applicant's amendments.
3. The rejection of claims 10, 12-19, and 21-27 under 35 U.S.C. § 101 is maintained and clarified below in view of the recent *Bilski* decision.

### ***Response to Arguments***

4. Applicant's mere assertion that the claims are directed to statutory subject matter is not persuasive.

### ***Claim Rejections - 35 USC § 101***

5. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

6. Claims 10, 12-19 and 21-27 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

A claim that requires one or more acts to be performed defines a process. However, not all processes are statutory under 35 U.S.C. § 101. To be statutory, a claimed process must either: (1) be tied to a particular machine or apparatus, or (2) transform a particular article into a different state or thing. *In re Bilski*, 545 F.3d 943, 954 (Fed. Cir. 2008) (en banc).

If the limitations tying the process to a computer are not actually limiting, *i.e.*, they do not reduce the preemptive footprint of the claim, then the process is not sufficiently tied to a particular machine or apparatus to be statutory. *Id.* at 955 (citing *Gottschalk v. Benson*, 409 U.S.

Art Unit: 2192

63, 71-72 (1972)). Mere field-of-use limitations are generally insufficient to render an otherwise ineligible process claim patent-eligible. *Id.* at 957 (citing *Diamond v. Diehr*, 450 U.S. 175, 191-192 (1981)). Nor will insignificant extrasolution activity render such a process statutory. *Id.* (citing *Diehr*, 450 U.S. at 191-92; *In re Schrader*, 22 F.3d 290, 294 (Fed. Cir. 1994)).

Regarding transformation of data, the en banc panel in *Bilski* noted that an algorithm (an unpatentable fundamental principle) merely combined with a data-gathering step was non-statutory because, “A requirement simply that data inputs be gathered—without specifying how—is a meaningless limit on a claim to an algorithm because every algorithm inherently requires the gathering of data inputs,” and, “Further, the inherent step of gathering data can also fairly be characterized as insignificant extra-solution activity.” *Id.* at 963 (citing *Parker v. Flook*, 437 U.S. 584, 590 (1978)). Further, transformations of abstractions do not meet the test for transformation of an article to a different state or thing because, “[Such abstractions] are not physical objects or substances, and they are not representative of physical objects or substances.” *Id.* at 963-64.

For a claimed process to be patent-eligible, the use of a specific machine or transformation of an article must impose meaningful limits on the claim's scope, and the involvement of the machine or transformation in the claimed process must not merely be insignificant extra-solution activity. *Id.* at 961-62.

Nominal recitations of structure in an otherwise ineligible method fail to make the method a statutory process. *See Gottschalk v. Benson*, 409 U.S. 63, 71-72 (1972). As Corniskey recognized, “the mere use of the machine to collect data necessary for application of the mental process may not make the claim patentable subject matter.” *In re Comiskey*, 499 F.3d 1365,

Art Unit: 2192

1380 (Fed. Cir. 2007) (citing *In re Grams*, 888 F.2d 835, 839-40 (Fed. Cir. 1989)). Incidental physical limitations, such as data gathering, field of use limitations, and post-solution activity are not enough to convert an abstract idea into a statutory process. In other words, nominal or token recitations of structure in a method claim do not convert an otherwise ineligible claim into an eligible one. To permit such a practice would exalt form over substance and permit claim drafters to file the sort of process claims not contemplated by the case law. *Cf. Parker v. Flook*, 437 U.S. 584, 593 (1978) (rejecting the respondent's assumption that "if a process application implements a principle in some specific fashion, it automatically falls within the patentable subject matter of § 101," because allowing such a result "would make the determination of patentable subject matter depend simply on the draftsman's art and would ill serve the principles underlying the prohibition against patents for 'ideas' or phenomena of nature.").

The "result" of claims 10, 12-19 and 21-27 appears to be a series of calculations, or at best, the insertion of instructions into an abstraction of a computer program (see, for example, claim 21, lines 15-16). Thus the claims involve the mere manipulation of abstract ideas, with the only recitation of structure being the nominal recitation in the preamble citing a "computer-implemented method." This recitation is so generic as to encompass any computing system, such that anyone who performed this method in practice would fall within the scope of these claims. Thus, the recitation of a computer apparatus in the preamble is not, in fact, a limitation at all to the scope of the claim, and the claim is directed, in essence, to the method performed by any means.

***Conclusion***

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

8. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Eric B. Kiss whose telephone number is (571) 272-3699. The Examiner can normally be reached on Tue. - Fri., 7:00 am - 4:30 pm. The Examiner can also be reached on alternate Mondays.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Tuan Dam, can be reached on (571) 272-3695. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Art Unit: 2192

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Eric B. Kiss/

Eric B. Kiss

Primary Examiner, Art Unit 2192